



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,632	11/21/2003	Robert C. O'Brien	31611.0028	3465

33751 7590 08/12/2005

WILSON GREATBATCH TECHNOLOGIES, INC.
10,000 WEHRLE DRIVE
CLARENCE, NY 14031

EXAMINER

FAULCON JR, LENWOOD

ART UNIT	PAPER NUMBER
----------	--------------

3762

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/719,632	Applicant(s) O'BRIEN ET AL.	
	Examiner Lenwood Faulcon, Jr.	Art Unit 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malonek et al. (U.S. Patent No. 6,292,704) in view of Lieber et al. (U.S. 2002/0117659).

Malonek et al. teaches of high capacitance implantable electrodes, which comprise a substrate selected from the group of platinum, platinum-iridium, titanium and carbon (col. 3 lines 65-67). Malonek et al. further teaches of the implantable electrodes comprising a coating supported on the substrate (col. 3 lines 10-15). Malonek et al. also teaches that the coating may be selected from a group of materials including iridium oxide, titanium nitride (col. 4 lines 3-5), and the materials are inherently biocompatible and electrically conductive based on their known characteristics. Malonek et al. further teaches of the use of metal nitrides in particle coatings (col. 1 lines 61-62) and the use of heat treatment on the substrate (col. 9 lines 11-15). Malonek et al. teaches of methods for making implantable stimulation electrodes, which may comprise a metal substrate coated with tantalum oxide (col. 1 lines 27-37). Malonek et al. does not teach the use of a multiplicity of carbon-containing nanotubes adhering to the coating.

Lieber et al. teaches the use of carbon containing nanotubes, nanowires and nanorods (paragraph 79), for use in implantable medical devices, such as measurement and sensory devices (paragraph 162).

At the time of the invention it would have been obvious to one having ordinary skill in the art to combine the teachings of Malonek et al. with those of Lieber et al. Since both Malonek et al. and Lieber et al. involve the same field of endeavor, which includes implantable medical devices that utilize electrodes comprised of various substrates and coatings, they teach of analogous arts. It would have been obvious to modify the lead and methods of Malonek et al. by adhering a multiplicity of carbon-containing nanotubes to the coating for the purpose of strengthening the electrode. Therefore, it would have been obvious at the time of the invention to combine the teachings of Malonek et al. and Lieber et al. to meet the limitations of claims 1-5.

3. Claims 6, 7, 14-19 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malonek et al. (U.S. Patent No. 6,292,704) in view of Lieber et al. (U.S. 2002/0117659) as applied to claims 1-5 and 10 above, and further in view of Smalley et al. (U.S. 2002/0085968).

Smalley et al. teaches of a method for producing self-assembled objects comprising nanotubes that may be used singularly or in multiples (paragraph 16), for use in biocompatible implants (paragraph 276). Smalley et al. also teaches the use of nanotube ropes (paragraph 68). Smalley et al. further teaches of the use of nanotubes of carbon-doped boron nitride (paragraph 267). Smalley et al. also teaches of the use of binder precursors of any transition metal catalyst including iridium and platinum

Art Unit: 3762

(paragraph 161), in oxidizing conditions (paragraph 166). Smalley et al. also teaches of the use of plasma assisted chemical vapor deposition process (paragraph 72) and providing throughout the process by way of a microwave (paragraph 171).

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Malonek et al. and Lieber et al. as applied to claims 1-5 and 10 above, with the teachings of Smalley et al. Malonek et al., Lieber et al. and Smalley et al. teach of analogous art, since they disclose applications of implantable medical devices that utilize electrodes. Modifying the electrodes as taught by Malonek et al. and Lieber et al. with the teachings of Smalley et al. to increase the strength and durability of the electrode would have been obvious to one having ordinary skill in the art, since the various types of nanotubes are known for the strength characteristics.

4. Claims 8, 9 and 11-13, 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malonek et al. (U.S. Patent No. 6,292,704) in view of Lieber et al. (U.S. 2002/0117659) as applied to claims 1-7, 10, 14-15, 18-19 and 25-26 above, and further in view of Croci et al. (U.S. 2004/0151835).

Croci et al. teaches of a method for forming a coating film, consisting of nanotubes (paragraph 1). Croci et al. further teaches of growing the nanotubes from a reaction gas of acetylene (paragraph 66), which may also contain ammonium (paragraph 25) and the use of a hydrogen gas stream in the operation of forming the carbon nanotube coating on the substrate (paragraph 25). Croci et al. further teaches of maintaining the temperature of the substrate between 300°C and 1500°C during

Art Unit: 3762

formation of the nanotubes (paragraph 29) and then allowing the substrate to cool in a solution of iron nitrate, which also contains hydrogen (paragraph 51). Croci et al. further teaches of the use of nitrogen as a diluting gas (paragraph 26). Further, the limitation of cooling the nanotube coated substrate in hydrogen as stated in claim 13 lacks criticality.

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Malonek et al. and Lieber et al. as applied to claims 1-7, 10, 14-15, 18-19 and 25-26 above, with the teachings of Croci et al. Both Lieber et al. and Croci et al. deal with the problem of growing effective nanotubes by use of reaction gases, and thus are analogous arts. Modifying the reaction entity as taught by Lieber et al. (paragraph 65) with the teachings of Croci et al. would have been obvious to one having ordinary skill in the art, to increase the property characteristics of the nanotube.

Response to Amendment

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 11, 14, 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment filed June 8, 2005, contains new matter, which is not supported by the original disclosure. The new matter, which is

Art Unit: 3762

not supported by the original disclosure, is as follows: Claims 1, 11, 14, 20 and 25 contain the language that "the first and second ends are of the same polarity."

Response to Arguments

7. Applicant's arguments filed on June 8, 2005, have been fully considered but they are not persuasive. The amendments to claims 1, 11, 14, 20 and 25, contain language in the alternative, which do not overcome the prior art rejections. For the reasons set forth above, Malonek et al. is obvious over claims 1-5, and 10 in view of Lieber et al., Malonek et al is also obvious over claims 6, 7, 14-19 and 25-26 in view of Lieber et al. and Smalley et al., and Malonek et al. is further obvious over claims 8, 9 and 11-13, 20-24 in view of Lieber et al. and Croci et al.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cowland (U.S. Patent No. 3,722,005), Richter et al. (U.S. Patent No. 4,281,668), Parsonage et al. (U.S. Patent No. 5,338,430), Lorenz et al. (U.S. Patent No. 5,587,200), Nanci et al. (U.S. Patent No. 5,876,454), Schueller et al. (U.S. Patent No. 6,143,412), Loftus et al. (U.S. Patent No. 6,755,530), Mech et al. (U.S. 2002/0120296), Parsonage et al. (U.S. 2003/0093107), Supronowicz et al. (U.S. 2003/0153965), Motamedi et al. (U.S. 2004/0023317), Chen et al. (W.O. 3/049,219).

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 3762

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lenwood Faulcon, Jr. whose telephone number is 571-272-6090. The examiner can normally be reached on Monday-Thursday from 9 to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela D. Sykes, can be reached on 571-272-4955. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Lenwood Faulcon, Jr.


George Manuel

Primary Examiner